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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/657,687	09/08/2003	Salvatore Rea	2002L007A	1241

7590

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EXAMINER
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RONESI, VICKEY M

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 03/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/657,687

Applicant(s)

REA ET AL.

Examiner

Vickey Ronesi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>12/24/03</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 4 and 19 are objected for the following reasons:

With respect to claim , there is a typographical error. At the end of line 1 of the claim, the word "the" should be deleted.

With respect to claim 19, a multiple dependent should be in the alternative.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogano et al (US 6,207,625, cited on IDS dated 12/24/2003) in view of Brehm (US 3,893,168) and Holubec (US 3,876,550).

Ogano et al discloses a lubricant oil composition comprising sulfurized oxymolybdenum dithiocarbamate which is 400-2,000 ppm Mo (col. 4, lines 7-52); zinc dialkyl dithiophosphate which is 700-2000 ppm P (col. 4, line 53 to col. 4, line 22); and other additives such as 1-30 wt % viscosity index improver (col. 6, lines 34-41), pour point depressants (col. 6, lines 41-47), 0.1-15 wt % ashless dispersants such as polybutenyl succinimide (col. 6, lines 48-55), metallic detergents such as calcium salts of sulfonates and phenates (col. 6, lines 56-61), phosphorus-free

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antioxidants (col. 6, lines 61-66), antifoaming agents (col. 7, lines 38-40), and 0.01-3 wt % rust inhibitors such as alkenyl succinic acid half ester, fatty acid soap, and polyalcohol, and alkyl polyoxyethylene ether (col. 7, lines 32-36). The base oil is like those presently used and would intrinsically provide for the presently claimed NOACK volatility of less than 15%. The composition is used in diesel engines and it therefore would have been obvious to use the lubricant composition in a four-cycle marine engine which would require such a heavy-duty engine lubricant.

Ogano et al fails to disclose the use of specific rust inhibitors like presently claimed.

Brehm discloses a lubricant oil for use in multigrade oil formulations and teaches that a common antirust agent is an alkyl-phenoxy polyethoxy ethanol having 3-12 ethoxy groups (col. 2, lines 38-68).

Holubec discloses lubricant compositions and teaches common anti-rust additives which can be used in mixtures (col. 3, line 63 to col. 6, line 49).

Given that Ogano et al discloses a lubricant composition open to the use of a variety of known anti-rust agents and further given common anti-rust agents in lubricant compositions taught by Brehm and Holubec, it would have been obvious to one of ordinary skill in the art to utilize a plurality of known anti-rust agents in the lubricant composition of Ogano et al, absent a showing of surprising or unexpected results.

3. Claims 1-9 and 11-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Walker et al (US 6,444,624) in view of Brehm (US 3,898,168) and Holubec (US 3,876,550).

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Walker et al discloses a lubricant comprising having a Noack volatility of less than 15 comprising (col. 1, lines 34-67) one or more molybdenum-containing additives such as molybdenum dithiocarbamates (col. 4, line 6) providing for an amount of elemental molybdenum not greater than 1000 ppm; a calcium detergent additive such as sulfonates or phenates (col. 4, line 55); and other additives ((col. 5, line 24 to col. 6, line 51) including ashless dispersants such as hydrocarbon-substituted succinimides (0.1-20 mass %), phosphorus-free antioxidants, anti-wear agent such as zinc dialkyl dithiophosphate (0.1-6 mass %), viscosity modifier (0.01-6 mass %), anti-rust agent (col. 6, line 40), antifoam agent (col. 6, line 41), and a flow improver (col. 6, line 41). See Table in col. 7 for amounts of additives. The composition is used in diesel engines and it therefore would have been obvious to use the lubricant composition in a four-cycle marine engine which would require such a heavy-duty lubricant.

Walker et al fails to disclose specific anti-rust agents, i.e., rust inhibitors.

Brehm discloses a lubricant oil for use in multigrade oil formulations and teaches that a common antirust agent is an alkyl-phenoxy polyethoxy ethanol having 3-12 ethoxy groups (col. 2, lines 38-68).

Holubec discloses lubricant compositions and teaches common anti-rust additives which can be used in mixtures (col. 3, line 63 to col. 6, line 49).

Given that Walker et al discloses a lubricant composition open to the use of a variety of known anti-rust agents and further given common anti-rust agents in lubricant compositions taught by Brehm and Holubec, it would have been obvious to one of ordinary skill in the art to utilize a plurality of known anti-rust agents in the lubricant composition of Walker et al, absent a showing of surprising or unexpected results.

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### *Double Patenting*

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-19 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,642,188 alone or in view of Holubec (US 3,876,550). Although the conflicting claims are not identical, they are not patentably distinct from each other because of the reasons given below.

US '188 claims a lubricating oil composition comprising ashless dispersant, metal detergent, oil soluble molybdenum compound, zinc dialkyl dithiophosphate, and rust inhibitor such as ethoxylated alkyl phenol containing 2-10 moles of ethylene oxide per mole, wherein the composition has a NOACK volatility of less than 15%.

US '188 fails to claim a rust inhibitor systems comprising the ethoxylated alkyl phenol containing 2-10 moles of ethylene oxide per mole and another rust inhibitor such as a glycerol ester of a fatty acid, a half ester of a succinic acid and a glycol, or a succinic acid or anhydride.

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On the one hand, attention is drawn to col. 8, lines 57-60 of US '188 which discloses that other rust inhibitors include alkenyl succinate half ester, fatty acid soap, ester of fatty acid, and polyhydric alcohol. Case law holds that those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in an application defines an obvious variation of an invention claimed in the patent. *In re Vogel*, 422 F.2d 438, 164 USPQ 619,622 (CCPA 1970). Thus, it would have been obvious to one of ordinary skill in the art to utilize the disclosed rust inhibitors, including mixtures, in the invention of US '188. It is well settled that it is *prima facie* obvious to combine two ingredients, each of which is targeted by the prior art to be useful for the same purpose. *In re Lindner* 457 F.2d 506,509, 173 USPQ 356, 359 (CCPA 1972).

On the other hand, Holubec discloses lubricant compositions and teaches common anti-rust additives which can be used in mixtures (col. 3, line 63 to col. 6, line 49). Therefore, given that US '188 claims the use of rust inhibitors, it would have been obvious to one of ordinary skill in the art to utilize a plurality of known anti-rust agents taught by Holubec in the lubricant composition of US '188.

5. Claims 1-19 are directed to an invention not patentably distinct from claims 1-14 of commonly assigned U.S. Patent No. 6,642,188. Specifically, see the discussion set forth in paragraph 4 above.

The U.S. Patent and Trademark Office normally will not institute an interference between applications or a patent and an application of common ownership (see MPEP Chapter 2300). Commonly assigned U.S. Patent No. 6,642,188, discussed above, would form the basis for a

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rejection of the noted claims under 35 U.S.C. 103(a) if the commonly assigned case qualifies as prior art under 35 U.S.C. 102(e), (f) or (g) and the conflicting inventions were not commonly owned at the time the invention in this application was made. In order for the examiner to resolve this issue, the assignee can, under 35 U.S.C. 103(c) and 37 CFR 1.78(c), either show that the conflicting inventions were commonly owned at the time the invention in this application was made, or name the prior inventor of the conflicting subject matter.

A showing that the inventions were commonly owned at the time the invention in this application was made will preclude a rejection under 35 U.S.C. 103(a) based upon the commonly assigned case as a reference under 35 U.S.C. 102(f) or (g), or 35 U.S.C. 102(e) for applications pending on or after December 10, 2004.

6. Claims 1-19 are rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent No. 6,642,188. See the discussion set forth in paragraph 4 above.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in



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the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

***Contact Information***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vickey Ronesi whose telephone number is (571) 272-2701. The examiner can normally be reached on Monday - Friday, 8:30 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

3/15/2006

vr



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